

REMARKS

Review and reconsideration of the non-final Office Action mailed February 3, 2009 (the "Office Action"), is respectfully requested in view of the preceding amendments and the following remarks. Although no fees are believed due, the Commissioner is hereby authorized to charge any deficiency or credit any surplus to Deposit Account No. 14-1437.

At the time of the Office Action, claims 1-11 were pending, with all claims being rejected under 35 U.S.C. §103 and 35 U.S.C. §112, second paragraph. By this Response, claims 1, 3, 5, 6, 10 and 11 are amended and claims 12-15 are added. Support for the subject matter of these amendments can be found throughout the specification. *See, e.g.*, Specification, Paragraphs [0015], [0039] & [0042]. No new matter is added.

The amendments presented herein have been made solely to expedite prosecution of the instant application to allowance and should not be construed as an indication of Applicant's agreement with or acquiescence to the Examiner's position. Accordingly, Applicants expressly maintain the right to pursue broader subject matter through subsequent amendments, continuation or divisional applications, reexamination or reissue proceedings, and all other available means. The rejections and responses thereto are set forth fully below.

Claim Rejections – 35 U.S.C. § 112, Second Paragraph

In the Office Action, claims 1-11 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office Action asserts that the term "derivative" renders the term glycol derivative indefinite in claims 1 and 11, and that claim 5 is indefinite for including a range within a range.

By this Amendment, claims 1 and 11 are amended to recite "cosmetically useful glycol derivative." Those of skill in the art of cosmetic research and development know that there are standardized classes of compositions that are useful for developing cosmetics. These include

cosmetically useful glycol derivatives, which can be easily identified using standardized references, such as the Cosmetic, Toiletry and Fragrance Associate (CTFA) International Buyers Guide and ingredients given a name under the International Nomenclature Cosmetic Ingredient (INCI) standards. Accordingly, Applicants respectfully request that the rejection of claims 1 and 11 based on 35 U.S.C. §112, second paragraph, be withdrawn.

Applicants have made appropriate amendments to claim 5. Accordingly, Applicants respectfully request that the rejection of claim 5 based on 35 U.S.C. §112, second paragraph, be withdrawn.

Claim Rejections – 35 U.S.C. § 103

In the Office Action, claims 1, 2 and 4-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,318,774 issued to Alban *et al.* (hereinafter “Alban”) in view of U.S. Patent No. 5,565,216 issued to Coswar *et al.* (hereinafter “Coswar”), U.S. Patent No. 5,571,503 issued to Mausner (hereinafter “Mausner”), U.S. Patent No. 4,892,727 issued to Grollier (hereinafter “Grollier”), U.S. Patent No. 5,207,998 issued to Robinson *et al.* (hereinafter “Robinson”) and U.S. Patent No. 6,074,652 issued to Ishiwatari *et al.* (hereinafter “Ishiwatari”); and claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over the previously recited references, further in view of U.S. Patent Application Publication No. 2002/0085984 filed by DiGirolamo (hereinafter “DiGirolamo”). As amended, the water-proof mascara composition of claim 1 is drawn to:

1. (Currently amended) A water-proof mascara composition which comprises
 - a) an oil phase comprising a liquid ester, an oil or a mixture thereof, 1 to 50% by weight of a silicon-based film-forming agent ~~on a silicone base~~, 0.1 to 10% by weight of a gel-forming agent selected from among fatty acids, fatty acid esters, cosmetically useful glycol derivatives and mixtures thereof;
 - b) ~~[[+]] 7 to 15~~ [[50]]% by weight of ~~substances selected from among~~ pigments, powders with a pigment-like effect, fillers and mixtures thereof;
 - c) a water phase comprising 42 to 75% by weight of water;

- d) 0.1 to 10% by weight of a surface-active agent; and
- e) ~~ad-100% by weight~~ further carrier substances, auxiliaries, active agents or mixtures thereof, all percentages being relative to the total weight of the composition, wherein the composition is free of waxes and hydrocarbon solvents, wherein said water-proof mascara composition comprises an emulsion, and wherein the applied water-proof mascara composition exhibits no statistically increased amount of streaking, smudging or flaking after immersion in water.

Of particular interest, the claimed water-proof mascara composition is in the form of an emulsion and includes 7 to 15 wt-% of pigments and/or powders with pigment-like effect. Specification, Paragraph [0019]. Pigments and/or powders with pigment-like effect are known emulsion breakers, so the presence of 7-15 wt-% pigments in a stable emulsion is an unexpected result. Specification, Paragraph [0036]. In addition, although the claimed water-proof mascara composition includes no hydrocarbon solvents or waxes, and includes a large amount of water, *i.e.*, 42 to 75 wt-%, the claimed mascara exhibits no increased streaking, smudging or flaking when immersed in water. This is an extremely unexpected result considering that water-proof mascara compositions typically require a substantial amount of hydrocarbon solvents and/or waxes, and little or no water. Specification, Paragraph [0034].

The Office Action notes that the phrase “waterproof mascara composition” in the preamble was not considered in evaluating patentability. Office Action, Page 12 (*citing* MPEP §2111.02). Applicants note that the body of the claim now includes reference to a water-proof mascara and features thereof. Applicants note that water-proof mascara compositions must be water-proof, form stable films, exhibit abrasion resistance, produce homogeneous distributions of pigments, and produce homogeneous application to eye lashes. However, unlike lotions, a mascara would not provide a smooth skin felling or a moisturizing effect. Furthermore, the properties of a mascara would be undesirable for a skin lotion. As the body of the amended claims now positively recite a water-proof composition, a proper rejection of the amended claims now requires consideration of the fact that the claimed composition is a water-proof mascara.

As an initial matter, Applicants note that none of the cited references disclose a mascara composition. Rather, the cited references belong to different fields of the cosmetic industry, such as skin lotions, sunscreens, hair shampoos, hair relaxing compositions, lipsticks and so on. In particular, the primary reference, Albans, is drawn to a lotion for imparting an artificial tan to human skin. Albans, Abstract. Applicants respectfully submit that modifying the skin tanning lotion of Albans to form a water-proof mascara would render Albans unsatisfactory for its intended purpose.

In this regard, the relevant portion of the MPEP states:

**V. THE PROPOSED MODIFICATION CANNOT RENDER THE
PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE**

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

MPEP 2143.01.V.

As modifying Alban's skin lotion to have the properties of a mascara would render the skin lotion unsatisfactory for its intended use, Applicants respectfully submit that the modifications suggested in the Office Action cannot establish a *prima facie* case of obviousness against the amended claims. See MPEP 2143.01.V. In view of the aforementioned facts, Applicants respectfully submit that that only possible way to assert the instant case of obviousness is improper hindsight reconstructions. MPEP 2145.

Applicants note that the claimed water-proof mascara does not include any waxes and includes 42-75 wt-% water. Because of this, it is very surprising that the claimed compositions form a stable water-proof mascara, as wax levels up to 20% are generally needed to get a stable water-proof mascara. In contrast to expectations, the claimed water-proof mascara produces a stable aqueous gel using the silicone-based film forming agents and other claimed ingredients in

the claimed amounts. The claimed water-proof mascara is highly balanced and developed only after an unexpected result occurred after extensive experimentation. This balance of ingredients is neither disclosed nor suggested by the cited references.

Applicants also note that the inclusion of pigments in aqueous cosmetic compositions is very difficult because pigments are hydrophobic and thus need a hydrophobic solvent. Specification, Paragraph [0036]. In addition, it is well known that pigments are known to exhibit emulsion breaking properties. These problems are complicated by the fact that the claimed water-proof mascara composition includes a large amount of pigment, *i.e.*, 7-15 wt-%. This is yet another unexpected result achieved by the careful balancing of ingredients developed by the Applicants while developing the claimed water-proof mascara.

Alban discloses a skin tanning lotion that comprises dihydroxyacetone (DHA) and at least one alkyl hydroxyalkylcellulose or a derivative thereof. Neither DHA nor alkyl hydroxyalkylcellulose or derivatives thereof are typically found in mascara compositions. Thus, Alban is not suitable for a mascara composition.

The Office Action asserts that fatty acid esters, such as glyceryl esters are used in Alban's tanning compositions. However, Alban notes that it is important that the fatty acid esters and hydroxyalkylcellulose are present in a proper weight ratio (col. 6, lines 26 - 36). Thus, the skilled person is not motivated from Alban to use fatty acid esters alone, as in the claimed water-proof mascara composition.

In addition, Alban discloses that agents suitable for aesthetic purpose such as fragrances, pigments etc. can be included optionally into the tanning lotions. Alban, Col. 10, lines 62 - 64. However, the Alban examples show that only fragrances are incorporated into the tanning composition. Thus, one of skill in the art would understand that, as used in Alban, pigments are part of a catchall sentence and not actually used by Alban. But pigments are one of the substances which are absolutely necessary in every mascara composition. The mascara of the present invention comprises preferably 7 to 15 wt-% of pigments. Specification, Paragraph

[00020]. As explained above, Applicants have unexpectedly been able to formulate a water-proof mascara compositions with such high amounts of pigments by using the claimed amounts of the claimed ingredients.

Applicant respectfully submit that a person of skill in the art would understand that body lotions, such as the tanning compositions disclosed in Albans, contain a high water-content. In contrast, water-proof mascara usually contain hydrocarbons and no or only small amounts of water. Thus, it is very surprising that the claimed composition can include 42-75 wt-% of water and form a water-proof mascara that is a stable emulsion without using any waxes or hydrocarbons.

Mausner discloses a cosmetic composition providing significant protection against pollutants in the environment. The Mausner composition includes at least an anti-pollution complex, a micellar complex, an anti-free radical complex and a sunscreen. Mausner, Claim 1. Applicants submit that a person skilled in the art would not be motivated to use an anti-pollution composition to modify a skin tanning lotion in order to formulate a mascara. Further, the skilled person would not combine the teaching of Mausner and Alban because Mausner provides a skin protection composition and Alban discloses a tanning composition belonging to the field of decorative cosmetics.

Edmundson was cited to show that dimethicone is a silicone oil. However, Applicants respectfully submit that it is not obvious to combine the teachings of Edmundson with Alban and Mausner to produce the claimed water-proof cosmetic because Edmundson discloses a lipstick composition comprising at least 8 wt-% of a hydrocarbon solvent, *i.e.*, isohexadecane, and waxes, *e.g.*, beeswax. Thus, the teaching of Edmundson is not adoptable for a water-proof mascara that is wax-free and hydrocarbon-free.

Cowsar was cited to show that cetareth-20 is a non-ionic emulsifier. However, Applicants respectfully submit that it would not be obvious to combine the teachings of Cowsar with the other cited references in order to produce the claimed water-proof mascara. The

composition of Cowsar is drawn to a hair relaxing systems that comprises a water-soluble salt of a relatively strong base that provides a pH of between 12 and 14 when in an aqueous medium. Cowsar, Col. 6, lines 4-7 and 56-58. The alkaline solution can dramatically burn the eyes so that the use of such compositions for eye lashes would be dangerous.

Robinson was cited to show that the non-ionic emulsifiers, *e.g.*, cetareth-20, can be used in a range from 0.1 – 10 wt-%. However, Robinson is drawn to a sunscreen composition that includes waxes and hydrocarbons in an oil phase. Robinson, Col. 5, lines 51-52 and lines 56-57. It would not be obvious to combine the teaching of Robinson and Cowsar, which include waxes and hydrocarbons as key ingredients with the other references, in order to produce a water-proof mascara that does not includes waxes or hydrocarbons. This is particularly true where, as here, waxes and hydrocarbons are common ingredients of water-proof mascaras. Furthermore, it would not be obvious to modify Alban in view of Robinson, both of which are skin lotions, in order to produce a mascara composition. Finally, the stability of pigments in a composition with hydrophobic waxes and hydrocarbons is simply not relevant to the claimed water-proof mascara, which is free of waxes and hydrocarbons.

Grollier discloses that powders of lupin seeds can be incorporated into cosmetic compositions for treatment of oily skin or oily hair thereby taking advantage of the absorption properties of the powdered lupine seeds. Grollier, Col. 1, lines 60-64. Applicants note that there is no known problem in the art with respect to oily eyelashes. In addition, powdered lupine seeds exhibit a high absorption capacity for both oil and water. Grollier, Col. 2, lines 11-12. In contrast to Grollier, the claimed water-proof mascara composition is water-proof and should not absorb water or oil which comes into contact with the eyelashes. As amended, the claims require 7 to 15 wt-% of pigments or powders with a pigment-like effect. The lupine seeds of Grollier simply do not meet this limitation and a mascara containing lupine seeds could not produce a water-proof mascara. Thus, it would not be obvious to combine the skin tanning lotion of Alban with the oily hair treatment of Grollier to produce the claimed water-proof mascara.

Ishiwatari was cited to show that trimethylsiloxysilicate is a known silicone-based film-forming agent which is used in the range from 0.1 to 50 wt-%. However, the emulsion of Ishiwatari comprises at least an α -monoalkyl glyceryl ether, a wax and a silicone oil (claim 1), wherein the wax is contained in the range from 0.2 to 20 wt-%. In addition, Ishiwatari includes limited amounts of pigment. As one can see in Figure 2 of Ishiwatari, compositions without beeswax are not stable. As explained above, the claimed it was not the object of the present invention to provide a water-proof mascara which contains waxes, but to provide a wax-free composition. Ishiwatari does not disclose or suggest a water-proof mascara that is wax-free, hydrocarbon free, and includes the proper amounts of pigment and other ingredients.

In summary, Applicants note that Alban is not drawn to a water-proof mascara and there would be no motivation to modify Alban to produce a water-proof mascara because the necessary modifications would render Alban unsatisfactory for its intended use, *i.e.*, as a skin tanning lotion. MPEP 2143.01.V. Furthermore, the other cited references are drawn to cosmetic compositions that have nothing to do with the claimed water-proof mascara. In addition, the majority of the cited references are drawn to cosmetics that include waxes and/or hydrocarbons. Finally, there is nothing in the cited references to disclose or suggest a water-proof mascara, or the desirability of producing a water-proof mascara that is free of waxes and hydrocarbons.

For at least the reasons described above, Applicants respectfully submit that the cited references fail to disclose or suggest the claimed water-proof mascara set forth in amended claim 1. Accordingly, applicant respectfully request that the rejection based on the combination of Alban, Cowsar, Mausner, Grollier, Robinson, and Ishiwatari, be withdrawn.

In the Office Action, claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable in view of U.S. Patent Application Publication No. 2002/0081322 filed by Lawson *et al.* (hereinafter “Lawson”) in view of U.S. Patent No. 5,451,405 issued to Zhang *et al.* (hereinafter “Zhang”), U.S. Patent No. 6,391,835 issued to Gott *et al.* (hereinafter “Gott”), U.S. Patent No. 5,013,763 issued to Tubesing *et al.* (hereinafter “Tubesing”) and U.S. Patent No. 5,126,136

issued to Merat *et al.* (hereinafter “Merat”).

Applicants note that Lawson is drawn to a non-emulsion, topical gel composition with substantially no oil. *See* Lawson, Abstract. Lawson discloses that the topical gel composition disclosed therein can be useful in a variety of cosmetics. However, the list of uses does not include mascaras, much less water-proof mascaras. *See* Lawson, Paragraph [0016].

In addition, in contrast to claim 11, Lawson emphasizes that the gel cosmetics disclosed therein should not be in the form of emulsions and should not include high oil contents. In particular, Lawson explains that the gel cosmetics disclosed therein should contain less than 5% oil, preferably less than 3% oil, in order to avoid the formation of an emulsion. In contrast, the claimed water-proof mascara includes 15-30 wt-% silicon-based film-forming compounds, including silicon oils, and are in the form of an emulsion.

In addition, it is well known that pigments, such as the claimed iron oxides, mica, talc, kaolin, etc., are known to break emulsions generally act as emulsion breakers. Thus, while Lawson discloses pigments, Lawson specifically requires that the cosmetic is not drawn to an emulsion. In contrast, Applicants were unexpectedly able to produce a stable emulsion using the claimed ingredients in the claimed amounts.

Similarly, the remaining references are not drawn to mascara compositions of any sort. In particular:

- (1) Tubesing is drawn to a wash of hand or body lotion and does not make a single reference to an emulsion. *See* Tubesing, col. 1, ln. 5-8;
- (2) Gott is drawn to an alkyl diol impregnated dry cleansing wipe, not a mascara, or even a topical cosmetic composition. *See* Gott, Abstract;
- (3) Zhang is drawn to a skin treatment composition for enhancing lipid biosynthesis in mammalian skin. *See* Zhang, col. 1, ln. 5-9; and
- (4) Merat is drawn to a skin protection lotion that will protect skin from a wide range of hazardous fluids. *See* Merat, Abstract.

Based on Lawson’s strong teaching away from oils and emulsions, there would be no motivation to modify Lawson by adding oils and forming an emulsion. Furthermore, since none

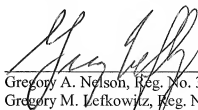
of the cited references is drawn to a mascara composition, any optimization of any ingredient would be to produce an improved lotion, not the claimed water-proof mascara. Furthermore, because pigments are known to break emulsions, there would be no expectation of producing a stable, emulsion containing 1-15 wt-% pigment as required by the claimed mascara compositions. Accordingly, Applicants respectfully request that the rejection based on the combination of Lawson, Zhang, Gott, Tubesing, and Merat be withdrawn.

Conclusion

For at least the reasons set forth above, the independent claims are believed to be allowable. In addition, the dependent claims are believed to be allowable due to their dependence on an allowable base claim and for further features recited therein. The application is believed to be in condition for immediate allowance. If any issues remain outstanding, Applicant invites the Examiner to call the undersigned if it is believed that a telephone interview would expedite the prosecution of the application to an allowance.

Respectfully submitted,

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